

Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, claim 20 is amended. These amendments to the claims constitute a bona fide attempt by applicant to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Support for the amendments can be found throughout the specification (e.g., page 12, lines 14-22) and thus, no new matter has been added. Claims 1-9 and 14-24 are pending.

Claim Rejections - 35 U.S.C. § 101

Claim 20 was rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully, but most strenuously, traversed.

Claim 20 has been amended to recite: "one or more computer-readable signal-bearing media that comprise one or more of a magnetic, electrical, optical, biological, and atomic data storage medium". Applicants believe that claim 20 complies with MPEP section 2106, IV. B. 1. Nonstatutory Subject Matter, second paragraph, as "functional descriptive material" recorded on "some computer-readable medium".

Withdrawal of the §101 rejection is therefore respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 6-9, 12-13, 15-16, 18-20, and 23-24 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Harrison et al. (U.S. Patent No. 6,418,216; "Harrison") in view of Chow et al. (U.S. Patent No. 6,470,179; "Chow"), and further in view of Lantto (U.S. Patent No. 5,867,784). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable

over Harrison in view of Chow and Lantto and further in view of Bales et al. (U.S. Patent No. 5,590,127; "Bales"). Claims 14, 17, and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harrison in view of Chow and Lantto and further in view of Vishwanathan et al. (U.S. Patent App. Pub. No. 2003/0017836; "Vishwanathan").

These rejections are respectfully, but most strenuously, traversed.

Applicants respectfully submit that the Office Action's citations to the applied references, with or without modification or combination, assuming, *arguendo*, that the modification or combination of the Office Action's citations to the applied references is proper, do not teach or suggest the initial address message that comprises the indicator for the barge-in service request, as recited in applicants' independent claim 1.

For explanatory purposes, applicants discuss herein one or more differences between the claimed invention and the Office Action's citations to Harrison, Chow, Lantto, Bales, and Vishwanathan. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the Office Action's citations to Harrison, Chow, Lantto, or Vishwanathan correspond to the claimed invention.

Harrison (FIG. 2) discloses a switch with an external processor to provide a barge-in procedure for a public switched telephone network. The Office Action alleges (page 4) that Harrison discloses the barge-in to allow the first user of the priority communication device to communicate with the second user of the mobile communication device. However, Harrison fails to disclose the initial address message that comprises the indicator for the barge-in service request.

Accordingly, the Office Action's citation to Harrison fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

The Office Action suggests a combination of Chow with Harrison. Applicants strenuously traverse the §103 rejection of the claimed invention on the following bases:

- (1) The combination of Chow with Harrison would change the principle of operation of Harrison.
- (2) Chow is not a pertinent reference.

First, Harrison requires a verification from the caller (i.e., via voice or keying in an authorization code; Abstract, lines 8-13). Harrison further states (Summary of the Invention):

...the call is automatically routed to or intercepted by telephone system apparatus adapted to: (a) verify that the caller is authorized to use automated barge-in... (col. 1, lines 46-48)

The process for confirming conditions (a) and (b) above, as presently contemplated, involves presentation of a recorded or synthesized announcement requiring the caller to speak or key in a password or other identification function... (col. 1, lines 62-65)

While Chow discloses (col. 17, line 53 to col. 18, line 3) the mobile switching center that receives the IAM message, the recorded or synthesized announcement of Harrison cannot be provided to the subscriber prior to the receipt of an initial address message received by the mobile switching center of Chow, as known by those skilled in the art. Accordingly, the proposed combination of Harrison with Chow would require a change in the principle of operation of Harrison, which is impermissible (MPEP 2143.01, section VI.).

Second, Chow is directed towards an automatic service selection feature in a local cordless services architecture (abstract). Chow shows no recognition of the problem of providing a barge-in on a call to a user of a mobile communication device and thus, Chow is not a pertinent reference.

Assuming, *arguendo*, that the combination of Harrison with Chow is proper, Chow fails to disclose the initial address message that comprises the indicator for the barge-in service request.

Accordingly, the Office Action's citation to Chow fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

The Office Action suggests a combination of Lantto with Harrison. Applicants strenuously traverse the §103 rejection of the claimed invention on the following bases:

- (1) The combination of Lantto with Harrison would change the principle of operation of Harrison.
- (2) Lantto is not a pertinent reference.

First, Lantto (col. 5, lines 13-25) discloses that an ISUP IAM message comprises various parameters for call reference information, identifying the call in the originating MSC and the signaling point code of the originating MSC, and network code information, identifying the originating network. As described above, the recorded or synthesized announcement of Harrison cannot be provided to the subscriber prior to the receipt of an initial address message received by the mobile switching center of Lantto, as known by those skilled in the art. Accordingly, the proposed combination of Harrison with Lantto would require a change in the principle of operation of Harrison, which is impermissible (MPEP 2143.01, section VI.)

Second, Lantto is directed towards improving speech quality for forwarded calls by avoiding unnecessary speech decoding (abstract). Lantto shows no recognition of the problem of providing a barge-in on a call to a user of a mobile communication device and thus, Lantto is not a pertinent reference.

Assuming, *arguendo*, that the combination of Harrison with Lantto is proper, Lantto fails to disclose the initial address message that comprises the indicator for the barge-in service request.

Accordingly, the Office Action's citation to Lantto fails to satisfy at least one of the limitations recited in applicants' independent claim 1.

MPEP §2143.01 states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

MPEP §2143.01 further states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990; *emphasis in original*).

Since both Chow and Lantto are directed towards different problems, applicants respectfully request a showing from within the references that would suggest their combination to maintain the §103 rejection. Both Lantto and Chow fail to make any mention of a barge-in and Harrison fails to make any mention of an initial address message.

The citations to Vishwanathan and Bales fail to disclose the initial address message that comprises the operator services information parameter with the special handling type value that comprises the authorization code, as described in the previous Responses.

The Office Action's citations to Harrison, Chow, Lantto, Bales, and Vishwanathan all fail to meet at least one of applicants' claimed features. For example, there is no teaching or suggestion in the Office Action's citations to Harrison, Chow, Lantto, Bales, or Vishwanathan of the initial address message comprises the operator services information parameter with the special handling type value that comprises the authorization code, as recited in applicants' independent claim 1.

For all the reasons presented above with reference to claim 1, claims 1, 15, and 20 are believed neither anticipated nor obvious over the art of record. The corresponding dependent

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claims are believed allowable for the same reasons as independent claims 1, 15, and 20, as well as for their own additional characterizations.

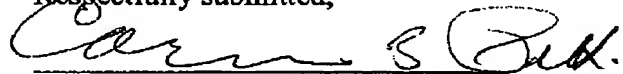
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Withdrawal of the § 103 rejections is therefore respectfully requested.

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In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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